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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/622,583 10/13/00 CAROSELLA

E 195707USOPCT

EXAMINER

022850 HM12/0327  
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ART UNIT

PAPER NUMBER

1656  
DATE MAILED:

03/27/01

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/622,583

Applicant(s)

CAROSELLA ET AL.

Examiner

Suryaprabha Chunduru

Art Unit

1656

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 13 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-13 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_

*Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- Group I            claims 1,4,12,13, drawn to a method for HLA-G transcription profile of a solid tumor, classified in class 435, subclass 69.1.
- Group II           claims 2 and 3, drawn to method establishing the HLA-G expression profile in view of selecting a treatment comprising antibody labeling, classified in class 435, subclass 7.23.
- Group III          claims 5-11, drawn to an antitumor vaccine composition, classified in class 424, subclass 277.1

The inventions are distinct, each from the other because of the following reasons:

- a.     Group I is independent and distinct from each of Groups II-III because the methods for HLA-G transcription profile of a solid tumor are materially different from the antibody labeling methods of Group II, are materially different from antitumor vaccine composition of Group III. Additionally, the methods for HLA-G transcription profile are not needed to produce the methods involving antibody labeling of Group II and antitumor vaccine composition of Group III because the methods involving antibody labeling and antitumor vaccine composition can be synthesized chemically or purified from natural sources. Neither are any of the methods involving antibody labeling or antitumor vaccine composition claimed in Groups II or III needed to produce or practice the method for HLA-G transcription profile.
- b.     Group II is independent and distinct from each of Groups I and III because the methods for HLA-G expression profile comprising antibody labeling of tumor cells can be used in materially different processes such as transfection, cloning assays and the antitumor vaccine

composition of Group III can be used in materially different processes such as transformation.

c. The antitumor vaccine composition of Group III is independent and distinct from Groups II and III because the methods for HLA-G transcription profile of Group I can be used in mutation detection and gene-knockout assays and the methods for HLA-G expression profile can be used in ligand-binding assays.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter and the search for one group is not required for any other group, restriction for examination purposes as indicated is proper.

A telephone call was made to James J. Kelly on March 12, 2001 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Applicant is reminded that upon the cancellation of claims to non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suryaprabha Chunduru whose telephone number is 703-305-1004. The examiner can normally be reached on 8.30A.M. - 4.30P.M, Mon - Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Jones can be reached on 703-308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-0294 for regular communications and - for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

  
Surya Prabha Chunduru  
March 13, 2001



**EGGERTON A. CAMPBELL  
PRIMARY EXAMINER**